

Application No. : 10/707,733  
Filed : January 8, 2004

REMARKS

Claims 36 – 38 and 59 – 78 were pending in the application. By this paper, Applicant has withdrawn Claims 66 – 78 pending Applicant's traversal. Accordingly, Claims 36 – 38 and 59 – 5 65 are presented for examination herein.

*Restriction Election*

Applicant herein elects with traverse the invention of Group I (Claims 36 – 65). Applicant traverses the Examiner's requirement for restriction as between Group I and Groups II 10 and III (i.e. Claims 66 – 78). With respect thereto, Applicant provides the following remarks:

**Groups I, II and III** – Applicant respectfully submits that the Examiner's characterization of the inventions of Groups I, II and III as distinct inventions is improper. Specifically, per page 2 of the Office Action, and citing MPEP § 806.05(d), the Examiner argues 15 that the inventions of Groups I, II and III “*are related as subcombinations disclosed as usable together in a single combination*”. Applicant notes that Per MPEP§806.05(d):

20 “*Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.*” {emphasis added}

Applicant respectfully submits that the Examiner's requirement for restriction is improper, as the claims in Groups I, II and III clearly overlap in scope. For example, Claim 36 25 (Group I), Claim 66 (Group II), and Claim 76 (Group III) each set forth a method for facilitating a hotel reservation. Furthermore, each of these Claims include method steps of, *inter alia*: “*populating a computer database*”, “*providing an online form*”, and “*performing a reverse auction*”. Accordingly, the Examiner's requirement for restriction citing the Group I, II and III 30 inventions as subcombinations disclosed as usable together in a single combination is improper and should be withdrawn.

In addition, the Examiner alleges that the requirement for restriction is proper because there would be a serious search and examination burden if restriction were not required. Per MPEP § 808.02:

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*"Where the inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:*

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*(A) Separate classification thereof: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.*

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*(B) A separate status in the art when they are classifiable together: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.*

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*(C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.*

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*Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions."*

{emphasis added}

Here, the Examiner has merely set forth a conclusory statement that one of the above reasons applies, without providing an appropriate explanation for why there would be a serious search burden on the Examiner. Furthermore, the Examiner has clearly identified that each of the Group 30 I, II and III inventions are not only defined in the same class (i.e., class 705) but has further gone on to state that each of these groups also possess the same subclass (i.e., subclass 5). The Examiner has provided no additional explanation as to why each of these groups would introduce a serious search burden.

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Accordingly, Applicant respectfully submits that the Examiner has committed clear error on two distinct bases by: (1) alleging that the Group I, II and III inventions are "related as

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subcombinations disclosed as usable together in a single combination"; and (2) by not establishing an explanation of why not requiring restriction would introduce a serious search burden onto the Examiner. Therefore, for at least those reasons given above, Applicant respectfully requests the Examiner withdraw the restriction requirement as between Groups I, II and III.

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*Other Remarks*

Applicant hereby specifically reserves all rights of appeal (including those under the Pre-Appeal Brief Pilot Program), as well as the right to prosecute claims of different scope in another 10 continuation or divisional application.

Applicant notes that any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

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Respectfully submitted,

GAZDZINSKI & ASSOCIATES, PC

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By:



Peter J. Gutierrez, III  
Registration No. 56,732  
11440 West Bernardo Ct., Suite 375  
San Diego, CA 92127  
Telephone No.: (858) 675-1670  
Facsimile No.: (858) 675-1674

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